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In re Application of
Michael S. H. Chu et al
Serial No.: 09/430,050
Filed: October 25, 1999
Attorney Docket No.: 1001.1258101

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: PETITION DECISION
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This is in response to the petition under 37 CFR 1.181, filed April 30, 2004, requesting withdrawal of Finality of the last Office action.

BACKGROUND

A review of the file history shows that the examiner mailed a non-Final Office action to applicants on June 30, 2003, setting a three month shortened statutory period for reply in which claims 2-9, 11-15, 21 and 24-31 were rejected under 35 U.S.C. 102(e) as anticipated by Heck '207. From page 2 to page 6 the examiner discussed the reference apparatus in detail and gave reasons why applicants' claims individually were anticipated. The examiner further responded to applicants' arguments which had been filed May 27, 2003, and which were directed to similar subject matter.

Applicants replied on September 29, 2003, and traversed the rejection over Heck '207. Applicants devoted pages 2-14 to presenting arguments meant to rebut the examiner's holding of anticipation mainly arguing that the structure of the reference does not perform the same function or in the same way as applicants' claimed invention.

The examiner mailed a Final Office action to applicants on December 31, 2003, setting a three month shortened statutory period for reply. The examiner repeated the rejection essentially verbatim from the previous Office action and then spent pages 6-9 responding to applicants specific points of argument.

Applicants filed this petition on April 30, 2004, as well as an amendment after Final rejection. The latter has not yet been acted on pending the decision on the petition.

DISCUSSION

It is noted that the petition was filed four months after the examiner's action of which applicants complain. 37 CFR 1.181(f) requires that such petitions be filed within two months of the action complained of or they may be dismissed as untimely. Clearly this petition is untimely and is dismissible for that reason alone as well as for other reasons set forth below.

Applicants petition the Finality of the last Office action on the basis they cannot properly formulate arguments for purposes of Appeal if the examiner does not fully explain her reasoning. Applicants argue that the tenor of the examiners non-Final Office action led them to believe that she did not understand the operation of standard hemostasis valves, such as Heck's '207, and their response attempted to fully explain conventional valve operation. Applicants contended that their valve operates differently and provided an explanation of its operation. Applicants now complain that the examiner ignored their explanation and responded in a manner which essentially summarily dismissed their arguments. Applicants further conducted a telephone interview in February, 2004, to persuade the examiner of the differences between the prior art and their valve.

A review of the Office action shows that the examiner did respond to all of applicants arguments fully and presented appropriate reasoning for the manner in which the reference, Heck '207, is being interpreted. That the examiner did not spend 10 pages answering applicants' arguments, but only three, is not dispositive of error on the examiner's part so long as the examiner's reasoning is clearly set forth which it is. It appears that the examiner and applicants have fully developed the statutory issues relating to patentability or unpatentability of the claimed valve and have taken opposite sides thereon each having presented appropriate reasoning and arguments. As such the issues are ripe for resolution by the Board of Patent Appeals and Interferences.

The petition is **DISMISSED**.

The application will be forwarded to the examiner for further consideration of applicants concurrently filed amendment. Applicants' time period for properly responding to the Final Office action, mailed December 31, 2003, remains as set therein.

Any request for reconsideration of this decision must be filed within TWO MONTHS of the mail date thereof.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 703-872-9306.

Jasemine C. Chambers
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